Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

<u>Ex parte</u> DAVID W. HILL,
SUSAN MOFFATT, ROBERT E. SPRINGER,
and JOHN D. SWANSEY

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES
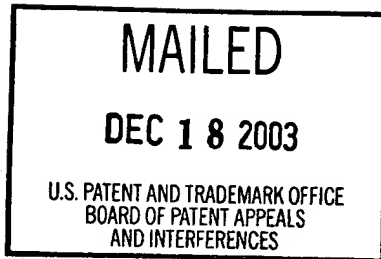
Appeal No. 2002-1090
Application 09/335,201[1]

ON BRIEF

Before HAIRSTON, BARRETT, and BARRY, <u>Administrative Patent Judges</u>.

BARRETT, <u>Administrative Patent Judge</u>.

<u>DECISION ON APPEAL</u>

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-12.

We reverse.

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[1] Application for patent filed June 17, 1999, entitled "PC Keyboard With Detachable Smartcard Security Device."

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BACKGROUND

The invention relates to a personal computer (PC) accessory unit, such as a smartcard security device, attached to a PC keyboard. This prevents clutter on the desktop and prevents the unit from being damaged or contaminated by the desktop.

Claim 1 is reproduced below.

> 1. A PC accessory unit for use with a desktop personal computer assembly including a PC keyboard, the PC keyboard being a stand alone component, the PC accessory unit comprising:
>
> a body structure incorporating electronic circuitry for operation with a PC; and
>
> a connecting assembly coupled to the body structure for attaching the body structure externally to the PC keyboard.

The examiner relies on the following references:

Arney et al. (Arney)   4,749,364   June 7, 1988
Knights   5,752,857   May 19, 1998

We refer to the final rejection (Paper No. 6) (pages referred to as "FR__") and the examiner's answer (Paper No. 16) (pages referred to as "EA__") for a statement of the examiner's rejection, and to the brief (Paper No. 14) (pages referred to as "Br__") and reply brief (Paper No. 17) (pages referred to as "RBr__") for a statement of appellants' arguments thereagainst.

Claims 1-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Knights. As noted by appellants (RBr3), although the examiner corrects appellants' statement of the issues to

state that only claims 1-8 are anticipated by Knights (EA2), on

the next page of the examiner's answer the examiner rejects

claims 1-10 as anticipated by Knights (EA3), and this is

consistent with the final rejection (FR2). Accordingly, we

assume that claims 1-10 are rejected over Knights. It is noted

that claims 11 and 12 depend directly or indirectly from claim 8,

but are not rejected over Knights.

Claims 9-12 stand rejected under 35 U.S.C. § 102(b) as being

anticipated by Arney. The examiner's statement of the rejection

over Arney in both the final rejection and the examiner's answer

mentions only claims 9 and 10, but the discussion includes

claims 11 and 12. Appellants assume that the rejection was

intended to include claims 11 and 12 (Br6) and, thus, we group

claims 11 and 12 with claims 9 and 10. However, claims 11 and 12

do not depend on claims 9 or 10. Since claims 6-8 are not

rejected over Arney, it appears that the examiner mistakenly

assumed that claims 11 and 12 depended on claim 9 or claim 10.

In the response to the final Office action (Paper No. 9),

appellants stated that claims 13 and 14 have been canceled, but

did not file a formal amendment doing so. In the brief,

appellants state that claims 13 and 14 were canceled (Br5). The

examiner noted that no amendment after final was filed (EA2).

Appellants state in their reply brief that they intended to

cancel claims 13 and 14, but inadvertently failed to file a

formal amendment; they request that claims 13 and 14 be canceled and withdrawn from consideration (RBr3). The examiner notes entry of the reply brief (Paper No. 18), but does not comment on claims 13 and 14. Since canceling of dependent claims can only simplify the issues for appeal, we assume that the examiner would enter a formal amendment canceling claims 13 and 14. In any case, we consider claims 13 and 14 withdrawn from appeal.

<div align="center">OPINION</div>

Claim interpretation

As a preliminary matter, we must interpret the claims. The first issue involves the limitation of a "stand alone keyboard." The examiner cites to definitions of "keyboard" in The IEEE Standard Dictionary of Electrical and Electronics Terms (6th ed., year unknown) and in The Illustrated Dictionary of Electronics (6th ed, year unknown), as an array of keys used to enter data (EA7-9 and App. A & C). Unfortunately, this does not address the relevant argued limitation of a "stand alone" keyboard. "Standalone" (or "stand alone") is defined as "[s]elf-contained and usually independently operating," The American Heritage Dictionary of the English Language (Fourth Ed., Houghton Mifflin Co., 2000). The normal interpretation in the computer art, absent some other interpretation justified by the examiner, is that a stand alone keyboard is a separate component from the display, the central processing unit (CPU) box, and the pointer

(mouse) device, as is common in desktop computers. While keyboards usually incorporate electronics, such as buffers and serial transfer logic, these are part of the keyboard function. Under this interpretation, a portable computer which integrates the keyboard and CPU is <u>not</u> a "stand alone keyboard."

The second issue involves the "for use with" limitations. Claim 1 recites "[a] PC accessory unit <u>for use with</u> a desktop personal computer assembly including a PC keyboard, the PC keyboard being a stand alone component," and claim 6 recites "[a] PC accessory unit <u>for use with</u> a stand alone keyboard." We interpret these "for use with" statements as statements of intended use of the PC accessory unit with a stand alone keyboard--only the PC accessory unit is claimed and the stand alone keyboard is not part of the combination and is not given patentable weight. Statements of intended use are not structural limitations that distinguish over the prior art <u>where the prior art is capable of that use</u>. See <u>In re Pearson</u>, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); <u>In re Yanush</u>, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973); <u>In re Casey</u>, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). In contrast, claims 9 and 10 recite a stand alone keyboard as part of the combination and not as an intended use.

The third issue involves the external attachment. Claim 1 recites "a connecting assembly coupled to the body structure for

attaching the body structure externally to the PC keyboard." This limitation can be interpreted to mean either that the body structure is external to the keyboard or that the attaching is external to the keyboard. We interpret the limitation to mean that the body structure is external to the keyboard. This is consistent with the disclosure of a reader 12 external to the keyboard in Figs. 4 and 5 even though the arms of the attachment unit 14 are internal. Appellants' arguments, which imply that the attaching must be external to the keyboard, appear to be inconsistent with the disclosure. Claim 6[2] recites "a connecting assembly coupled to the body structure; wherein the connecting assembly is coupled externally to the keyboard." Claim 8, which indirectly depends from claim 6, recites that the connecting assembly is a clip. Since the clip is received internally to the keyboard, we interpret "wherein the connecting assembly is coupled externally to the keyboard" to mean that the connecting assembly somehow interfaces with the exterior of the keyboard. Claim 14, which is either canceled or withdrawn from appeal, recites a Velcro strip, which would be external to the keyboard. However, to be consistent between claims 8 and 14, we assume that a clip which goes into the keyboard satisfies the limitations of

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[2] As noted by the examiner, the copy of claim 6 in the appendix to the brief is in error. The copy of claim 6 provided by the examiner in Appendix A to the answer is also in error because it recites "PC keyboard" instead of "keyboard" in two places. We refer to claim 6 in amendment A (Paper No. 5).

claim 6. Claims 9 and 10 recite "the keyboard configured to receive the connecting assembly and clip at the backside of the keyboard, such that the body structure is attached externally with the backside of the keyboard." As with claim 1, we interpret this to mean that it is the body structure that is external to the keyboard.

Claims 1-10

"Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

We go right to the determinative issue. Appellants argue that the Knights adapter is not attached to a stand alone keyboard (Br10). It is argued that the notebook computer in Knights is not a stand alone keyboard (Br10). It is argued that a keyboard does not include memory or a processor, but merely allows the user to communicate with the computer (Br10).

The examiner states that Figs. 1 and 7 of Knights show a stand alone keyboard. The examiner provides two definitions of "keyboard" and finds that the device 10 of Knights, with an array of lettered and numbered keys, is a stand alone keyboard (EA8).

The issue is not whether Knights discloses a keyboard, but whether it discloses a "stand alone" keyboard. The examiner does not address the specific "stand alone" language, but states only that the keyboard is shown as part of the computer in Knights. We have interpreted a "stand alone keyboard" to mean a separate component from the display, the CPU box, and the pointing device, as is common in desktop computers. We concluded that the portable computer in Knights which integrates the keyboard and CPU is not a "stand alone keyboard." The rejection of claims 9 and 10 over Knights is reversed for this reason.

Nevertheless, this does not quite resolve the rejection of claims 1 and 6, which only recite the intended use with a stand alone PC keyboard. Statements of intended use are not structural limitations that distinguish over the prior art where the prior art is capable of that use. Here, however, the adapter in Knights is not capable of use with a stand alone keyboard because a stand alone keyboard does not have the connections to the CPU that the permit the adapter to work. Thus, claims 1 and 6 implicitly require some other way of connecting the electronic circuitry for operation with the PC, which in not taught by Knights. The anticipation rejection of claims 1-8 is reversed.

Claim 9-12

Since claims 11 and 12 depend directly or indirectly from claims 6-8, and since claims 6-8 have not been rejected over Arney, the rejection of claims 11 and 12 is reversed pro forma. Apparently, the examiner mistakenly assumed that claims 11 and 12 depend from claims 9 and 10.

Appellants argue that Arney does not teach attaching the display to the keyboard, where the keyboard is "a stand alone PC keyboard." It is argued that the display in Arney is mechanically and electrically connected to the portable computer 101, not the keyboard (Br11; RBr8). It is further argued that Arney's display is not intended for use with a standard stand alone PC keyboard, but must be connected to a computer (Br11-12; RBr8). It is argued that "[b]ecause the portable computer incorporates a keyboard, the keyboard is not a stand alone component" (Br12; RBr9).

As discussed in connection with the rejection of claims 1-10, the examiner has not come to grips with the limitation of a "stand alone" keyboard. We find that the personal computer shown in Arney is not a "stand alone" keyboard because the keyboard and CPU are integrated into the case. Because Arney does not teach a body structure attached to a stand alone keyboard, the rejection of claims 9 and 10 is reversed.

CONCLUSION

The rejections of claims 1-12 are reversed.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

LEE E. BARRETT
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

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